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09/848,621	05/04/2001	Takeshi Ogaki	016887-1042	6000
22428	7590	07/13/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			BOVEJA, NAMRATA	
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			3622	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



### DETAILED ACTION

1. This office action is in response to communication filed on 04/24/2006.
2. Claim 8 is cancelled. Claims 1-7 and 9-13 are presented for examination.
3. Amendments to the claims and to the specification have been entered and considered.

#### Claim Rejections - 35 USC § 112

4. *The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:*

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.*

*There are two separate requirements set forth in this paragraph:*

- (A) the claims must set forth the subject matter that applicants regard as their invention; and*
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.*

*Claim 1 is rejected under 35 U.S.C. 112, second paragraph, since the recitation of the terms a point-of-sales (POS) system as the sales management system is unclear. Specifically, it is not clear if the POS and the sales management system the same thing. It is interpreted that they are the same. Secondly, the recitation of wherein the image forming unit prints out a leaflet having edited information of the advertisement and guidance information and the **information on specials** selected by the information selector based on a result of the statistical processing performed by the statistical data processors and in the POS systems sales and customer demographic data are retrieved based on the receipt numbers the result of retrieval is sent to the information*

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selector for retrieving **information on specials** according to the amount of money and advertisements according to the customer demographic data from the map and advertisement database wherein a **special-** and advertisement-added map on the advertiser is printed out is unclear, because it is unclear if there are three different **specials** as highlighted in the claim language or if they are all referring to the same set of **specials**. Thirdly, it is also unclear what is the applicant trying to claim here, since this portion of the claim initially recites getting information on **specials** from the information selector based on the results of the statistical data processor, it then recites getting information on **specials** from the POS system, and it finally recites printing of the **special** on the map. This portion of the claim is interpreted to mean that **specials** are selected based on the results of statistical processing that made use of a receipt ID and they are printed on the map. Fourthly, the recitation of the terms retrieving information on specials **according to the amount of money and advertisements according to the customer demographic data** is unclear, since it is not specifically stated according to what exactly is the information on **specials** retrieved. This is interpreted to mean that **specials** are determined based on total customer spending. Clarification is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not

*described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the retrieval of information on specials is not clearly defined in the specification. Furthermore, the specification does not describe how information on specials is retrieved according to the amount of money and advertisements according to customer demographic data. It is interpreted to mean that information on specials is retrieved based on the total amount of money spent by the customer. Appropriate correction is required.*

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Disclaimer:** *Claim 1 was found to be deficient under U.S.C. 112 first and second paragraphs. To the extent the claimed invention was understood, the following art was applied.*

Claims 1- 4 and 7 are rejected under U.S.C. 103(a) as being unpatentable over Yasuhiko (Japanese Publication Number JP11-126021-A hereinafter Yasuhiko) in view of Nicholson et al (Patent Number 6,332,128 hereinafter Nicholson).

In reference to claim 1, Yasuhiko teaches an image forming system having at least an image printing function, guidance information including a map being selectively

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formed and printed with information on specials by the image forming unit, the image forming system comprising: an information selector that selects and combines advertisement information offered by an advertiser (Page 3 lines 11-20, Page 4 lines 10-19, and Page 10 lines 3-21), guidance information including information having a name, a place, a route and a telephone number (Page 3 lines 11-20, Page 4 lines 1-13, Page 8 lines 16-19, Page 10 lines 3-21, Page 11 lines 15-26, Page 12 lines 12-16, and Figures 1-10) for designating the advertiser and information on specials including coupons to be used in purchasing goods or taking advantage of service offered by the advertiser (Page 5 lines 1-7, Page 12 lines 18-35, Page 14 lines 4-13, Page 18 lines 17 to Page 19 lines 8, and Page 23 lines 17-23); wherein the image forming unit prints out a leaflet having edited information of the advertisement and guidance information and the information on specials selected by the information selector (Page 3 lines 11-28, Page 21 lines 15-16, Page 22 lines 10 to Page 23 lines 23, and Figures 1-10); *manually issuing a receipt ID based on commodity purchase at a store for which the coupons are redeemed by stamping and marking at the store by the sales person on the coupon to indicate the customer purchased the item on the coupon* (Page 14 lines 4-13); and a map and advertisement database for storing guidance and advertisement data (i.e. a collection of data such as advertisements and maps that can be retrieved for printing) (Page 12 lines 12-16, Page 19 lines 19-23).

*Yusuhiko is silent about a point-of-sales (POS) system and statistical process that stores and manages sales and customer data, generates an electronic receipt based on the items purchased by the customer, stores this customer information in a*

*database, and retrieves specials based on the receipt ID number and the amount spent by a customer on a transaction.*

*Nicholson teaches a point-of-sales (POS) system as the sales management system for storing and managing sales and customer data (i.e. the POS dispenser and controller to manage data regarding total sales per customer) (col. 2 lines 53-65, col. 3 lines 58 to col. 4 lines 39, col. 5 lines 32-36, and col. 6 lines 14-65); an automated statistical data processor that issues an electronic receipt ID at the POS based on commodity purchase and customer demographic data entered via the POS system as the sales management system and retrieves commodity and customer data using the receipt ID for statistical processing (col. 5 lines 32-36 and col. 6 lines 14-20); and a commodity and customer database for storing commodity and customer data used for the statistical processing and a statistical data database for storing statistical data after processed by the statistical processing (col. 3 lines 9-16, col. 5 lines 17-20, and col. 8 lines 42-49); and in the POS system, retrieving the sales and customer demographic data based on the receipt number (col. 6 lines 15-20), the result of the retrieval is sent to the information selector for retrieving information on specials according to the amount of money and advertisements according to the customer demographic data from advertisement database (i.e. based on how much a user spends at the store, an appropriate discount is generated) (col. 4 lines 6-32).*

It would have been obvious for Yusuhiro to include the use of an *automated* statistical data processor to track the redemption of coupons for purchased items, to capture demographic data about who redeemed the coupon, *to generate electronic*

*receipt ID's that can be scanned, and to use this information to develop future targeted coupon leaflets for the users to provide relevant and useful coupons to the users which are likely to have a higher redemption rate and are therefore likely to lead to increased sales. It would have also been obvious for Yusuhiko to include the use of a receipt scanner to present the users with leaflet coupons that are based on current and past purchasing, and therefore have a greater likelihood of being redeemed rather than just sending out coupons in newspapers. Furthermore, it would have been obvious for Yusuhiko to utilize a point-of-sales (POS) system as the sales management system for storing and managing sales and customer data (i.e. the POS dispenser and controller to manage data regarding total sales per customer), since this would enable the retailers to collect information about the customers in real-time and in an automated manner to further enable for better targeting of the users who should receive specific coupons.*

7. In reference to claim 2, Yusuhiko teaches the image forming system wherein the information selector selects the content from those related to specials corresponding to goods or services offered by the advertiser in accordance with an amount of money (i.e. amount off or percentage off) used for purchasing at the store in which the terminal of the sales management system has been set and the image forming unit prints out the selected and edited information (Page 5 lines 1-7, Page 8 lines 17-19, Page 10 lines 12-21, Page 22 lines 6-8, Page 29 lines 15-17, Page 31 lines 7-8, and Figures 1-10).

Yusuhiko is silent about using the statistical data output by the statistical data processor to select coupon content including a period of validity. *Nicholson teaches using the statistical data output by the statistical data processor to select coupon*



*content (i.e. for a user who bought product A, will get a coupon for \$.02 off/gallon of gas versus someone who buys products A and B, will get a coupon for \$.04 off/gallon of gas) (col. 4 lines 6-32) including a period of validity (i.e. usable on the next purchase of gas) (col. 3 lines 58-65).*

It would have been obvious for Yusuhiko to include the use of a statistical data processor to track the redemption of coupons for purchased items, to capture demographic data about who redeemed the coupon, and to use this information to develop future targeted coupon leaflets for the users in order to provide relevant and useful coupons to the users which would have a higher redemption rate and lead to increased sales by the users. Furthermore, it would have been obvious for Yusuhiko to *include a period of validity on the coupons to motivate users to visit the stores again to take advantage of the discount.*

8. In reference to claim 3, Yusuhiko teaches the image forming system further comprising: receiving information by a reception controller (i.e. a salesperson can be considered a reception controller, since he will be capturing information regarding redeemed coupons manually) that users have taken advantage of specials sent from the advertiser including coupons selected and edited by the information selector (i.e. each redeemed coupon is stamped and marked at the store by the sales person to indicate receipt based on purchased commodity, and different coupons are printed for different advertisers according to the advertiser's requirements) (Page 3 lines 11-28, Page 14 lines 4-13, Page 21 lines 15-16, Page 22 lines 10 to Page 23 lines 23, and Figures 1-10).

Yusuhiko is silent about a statistical data processor to automatically account for utilization information. *Nicholson teaches a statistical data processor to automatically account for utilization information (col. 4 lines 33-39, col. 6 lines 15-65, and col. 8 lines 5-21).*

It would have been obvious for Yusuhiko to include the use of a statistical data processor to automatically account for utilization information to market subsequent coupons more intelligently and to target coupon issuance in a more cost effective manner by automating the collection of redemption data.

9. In reference to claim 4, Yusuhiko teaches the image forming system further comprising: receiving information by a reception controller (i.e. a salesperson can be considered a reception controller, since he will be capturing information regarding redeemed coupons manually) that users have taken advantage of specials sent from the advertiser including coupons selected and frequency of utilization (i.e. each time a coupon is redeemed coupon, it is stamped and marked at the store by the sales person to indicate receipt based on purchased commodity, and different coupons are printed for different advertisers according to the advertiser's requirements) (Page 3 lines 11-28, Page 14 lines 4-13, Page 21 lines 15-16, Page 22 lines 10 to Page 23 lines 23, and Figures 1-10).

Yusuhiko is silent about a statistical data processor to automatically account for utilization information. *Nicholson teaches a statistical data processor to automatically account for utilization information to determine that the coupons were redeemed and*

*who is redeeming the coupons (col. 4 lines 33-39, col. 6 lines 15-65, and col. 8 lines 5-21).*

It would have been obvious for Yusuhiko to include the use of a statistical data processor to automatically account for utilization information to market subsequent coupons more intelligently and to target coupon issuance in a more cost effective manner by automating the collection of redemption data.

10. In reference to claim 7, Yusuhiko teaches the image forming system wherein the image forming unit charges not a user but the advertiser (i.e. there is a charge associated with advertising in a newspaper for the advertiser, and by having multiple advertisements by different advertisers on the same leaflet, the costs can be shared) (Page 3 lines 1-9, Page 10 lines 27-30, Page 13 lines 13-17, and Page 19 lines 2-9) for a fee related to the guidance information including a map indicating a route to the advertiser and printed at the store in accordance with the amount of data printed in relation to the advertiser (Page 3 lines 11-20, Page 4 lines 1-13, Page 8 lines 16-19, Page 10 lines 3-21, Page 11 lines 15-26, Page 12 lines 12-16, and Figures 1-10).

11. In reference to claim 9, Yusuhiko teaches the image forming system wherein the image forming unit includes an MFP (i.e. a printer that prints the leaflets that can be distributed in a newspaper) having at least image printing and retrieving functions (i.e. a printer that can lay out the leaflet for printing with various information) (Page 8 lines 17-19, Page 10 lines 27 to Page 11 lines 13, Page 11 lines 28 to Page 12 lines 11, and Figures 1-10), the MFP printing out a map indicating a route to the advertiser designated by a name, a place, or a telephone number (Page 10 lines 3-21, Page 11

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lines 28 to Page 12 lines 16, and Figures 1-10), advertisements for a destination or surrounding stores and information on specials including coupons that can be used at a destination or surrounding stores (Page 5 lines 1-7, Page 12 lines 18 to Page 13 lines 4, Page 14 lines 4-13, Page 18 lines 17 to Page 19 lines 8, and Page 23 lines 17-23, and Figures 1-10).

Yusuhiko is silent about printing offers at the store (*i.e. at a POS terminal*) in which a terminal of *the* POS system functions as the sales management system and has a sales and customer data recording function. *Nicholson teaches printing offers at the store (col. 3 lines 9-11 and col. 5 lines 32-36) in which a terminal of a POS system functions as the sales management system has a sales and customer data recording function (i.e. to track which coupons are redeemed) (col. 6 lines 54-65).*

It would have been obvious for Yusuhiko to print offers at the store (*i.e. at a POS terminal*) in which a terminal of a POS system functions as the sales management system and has a sales and customer data recording function to ensure that the user is presented with the most up to date and targeted coupons, and so that the user will not have to remember to bring them to the store as they can be printed right there and then.

12. In reference to claim 10, Yusuhiko teaches the image forming system wherein the image forming unit retrieves and prints out a map corresponding to the advertiser (Page 10 lines 3-21, Page 11 lines 28 to Page 12 lines 16, and Figures 1-10).

13. Claims 5 and 6 are rejected under U.S.C. 103(a) as being unpatentable over Yasuhiko in view of *Nicholson* and further in view of Yanagisawa et al (Patent Number 6,961,710).

In reference to claim 5, Yusuhiko does not teach the image forming system further comprising: a transmission controller configured to control transmission of statistical data and printing charge information from the statistical data processor to the store, wherein the transmission controller informs the advertiser of a result of the accounting processing.

Yanagisawa teaches the image forming system further comprising: a transmission controller configured to control transmission of statistical data (i.e. number of times an advertisement is printed) (col. 14 lines 32-52) and printing charge information from the statistical data processor to the store (i.e. in store billing for advertisers) (col. 8 lines 44 to col. 9 lines 7), wherein the transmission controller informs the advertiser of a result of the accounting processing (i.e. how many times an advertisement is printed) (col. 14 lines 32-52).

It would have been obvious for Yusuhiko to include the use of a transmission controller configured to control transmission of statistical data and printing charge information from the statistical data processor to the store, wherein the transmission controller informs the advertiser of a result of the accounting processing in order to facilitate advertiser billing and to give information to the advertiser regarding how many times their advertisement was actually printed in a given time period.

14. In reference to claim 6, Yusuhiko teaches the image forming system wherein the information selector automatically controls the amount of data related to the advertiser and to be printed (i.e. there will be a specific combination of coupons and information

printed with the map according to a pre-specified size and layout limitations for the leaflet) (Page 3 lines 24-28, Page 9 lines 13-22, Page 10 lines 3-21, and Figures 1-10).

Yusuhiko is silent about printing the advertiser data at the store based on a result of the accounting processing. Yanagisawa teaches printing the advertiser data (i.e. coupons) at the store (col. 7 lines 54-67, col. 9 lines 8-33, and Figure 16) based on a result of the accounting processing (i.e. payment receipt and targeting based on payment selection by age group, time of day, and number of times an advertisement should be displayed) (col. 14 lines 28-52 and Figures 9-13) at a store (i.e. store terminal or kiosk) (col. 4 lines 63 to col. 5 lines 5).

It would have been obvious for Yusuhiko to print the advertiser data at the store based on a result of the accounting processing to deliver customized coupons according to the advertiser's specifications in terms of size of the advertisement etc. at a point of sale, where it would most likely get redeemed by the customer immediately.

15. Claims 11-13 are rejected under U.S.C. 103(a) as being unpatentable over Yasuhiko in view of *Nicholson* and further in view of Official Notice.

In reference to claim 11, Yusuhiko teaches the image forming system further comprising: an MFP as the image forming unit having the image printing and retrieving functions (Page 8 lines 17-19, Page 10 lines 27 to Page 11 lines 13, Page 11 lines 28 to Page 12 lines 11, and Figures 1-10); wherein the MFP prints out a map information indicating a route to the advertiser designated by a name, a place or a telephone number (Page 10 lines 3-21, Page 11 lines 28 to Page 12 lines 16, and Figures 1-10), advertisements for a destination or surrounding stores and information on specials

including coupons that can be used at a destination or surrounding stores (Page 5 lines 1-7, Page 12 lines 18 to Page 13 lines 4, Page 14 lines 4-13, Page 18 lines 17 to Page 19 lines 8, and Page 23 lines 17-23, and Figures 1-10).

Yusuhiko is silent about a POS system functioning as the sales management system by having a sales and customer data recording function, and a wireless communications system for allowing data transfer between a POS system and the MFP. *Nicholson teaches a POS system functioning as the sales management system including a sales and customer data recording function (i.e. to track which coupons are redeemed) (col. 2 lines 53-65, col. 3 lines 58 to col. 4 lines 39, col. 5 lines 32-36, and col. 6 lines 14-65) and printing data using a MFP that receives data from the POS system (col. 3 lines 9-23, col. 3 lines 63 to col. 4 lines 5, and col. 5 lines 32-36).*

It would have been obvious for Yusuhiko to print offers at the store (*i.e. at a POS terminal*) in which a terminal of a POS system functions as the sales management system including a sales and customer data recording function to ensure that the user is presented with the most up to date and targeted coupons, and so that the user will not have to remember to bring them to the store as they can be printed right there and then.

Official Notice is taken that it is old and well known within the computer arts to utilize a wireless communications system for allowing data transfer. This is done to enable users to connect to a network without the need of a hardwired connection and to utilize a cellular phone. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a wireless communications system for allowing data transfer to take place without the use of cables. One would

have been motivated to use a wireless communications system especially if an Internet hardwired connection point was not available, and in that case, a wireless would enable that location to gain a connection without having to install a hardwired connection point and running cable to that location.

16. In reference to claim 12, Yusuhiko teaches the image forming system wherein a map indicating a route to the advertiser designated beforehand is printed out by the MFP (Page 10 lines 3-21, Page 11 lines 28 to Page 12 lines 16, and Figures 1-10).

Yusuhiko does not teach printing at the store designated beforehand according to remote instruction sent by a wireless communications instrument of the wireless communications system. Official Notice is taken that it is old and well known within the business arts to submit print jobs wirelessly to save time by not having to print out the job upon reaching the store and by instead having the printed pages ready to go upon arrival to the store. An example of this is using a wireless computing device or a cellular phone to place a printing order with a store such as Kinko's. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to carry out printing beforehand according to remote instructions sent via wireless communication to save time at checkout in the store.

17. In reference to claim 13, Yusuhiko teaches the image forming system wherein the MFP has an image retrieving function that prints a map indicating a route to the advertiser (Page 10 lines 3-21, Page 11 lines 28 to Page 12 lines 16, and Figures 1-10).

**Response to Arguments**

18. After careful review of Applicant's remarks/arguments filed on 04/24/2006, the



Applicant's arguments with respect to claims 1-7 and 9-13 are presented for examination and have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the specification and claims have been entered and considered.

19. Applicant has sufficiently addressed previously held objections.
20. Applicant's amendment to claim 1 has caused the institution of new 35 USC § 112 rejections, since the claim is unclear and contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention as pertaining the claimed language around "**specials**" as addressed in detail in the rejection.
21. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

#### **Conclusion**

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

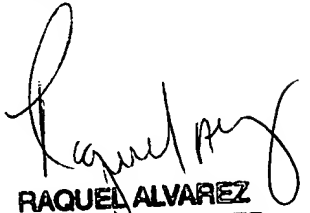
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. On July 15, 2005, the Central FAX Number changed to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

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July 7<sup>th</sup>, 2006

  
**RAQUEL ALVAREZ**  
**PRIMARY EXAMINER**